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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,066	08/24/2001	Rakesh Anand	P280384	1014

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EXAMINER

MYERS, CARLA J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,066

Applicant(s)

ANAND ET AL.

Examiner

Carla Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Restriction is required under 35 U.S.C. 121 and 372:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10, drawn to methods of detecting a polymorphism at position 288 of the PDK2 gene and primers and probes for detecting said polymorphism.

Group II, claims 1-10, drawn to methods of detecting a polymorphism at position 1281 of the PDK2 gene and primers and probes for detecting said polymorphism.

Group III, claims 1-10, drawn to methods of detecting a polymorphism at position 1357 of the PDK2 gene and primers and probes for detecting said polymorphism.

Group IV, claim 11, drawn to use of a PDK2 drug to prepare a medicament to treat a disease associated with a PDK2 polymorphism at position 288.

Group V, claim 11, drawn to use of a PDK2 drug to prepare a medicament to treat a disease associated with a PDK2 polymorphism at position 1281.

Group VI, claim 11, drawn to use of a PDK2 drug to prepare a medicament to treat a disease associated with a PDK2 polymorphism at position 1357.

Group VII, claim 12, drawn to a computer readable medium comprising nucleic acid sequence information for a polymorphism at position 288 of the PDK2 gene.

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Group VIII, claim 12, drawn to a computer readable medium comprising nucleic acid sequence information for a polymorphism at position 1281 of the PDK2 gene.

Group IX, claim 12, drawn to a computer readable medium comprising nucleic acid sequence information for a polymorphism at position 1357 of the PDK2 gene.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of group I is considered to be methods for detecting the presence of a polymorphism at position 288 of the PDK2 gene and allele specific primers and probes for detecting said polymorphism. The special technical feature of group II is considered to be methods for detecting the presence of a polymorphism at position 1281 of the PDK2 gene and allele specific primers and probes for detecting said polymorphism. The special technical feature of group III is considered to be methods for detecting the presence of a polymorphism at position 1357 of the PDK2 gene and allele specific primers and probes for detecting said polymorphism. Groups I, II, and III do not share a special technical feature because each of the polymorphisms detected in the methods of groups I, II and III are distinct and have their own structural and functional properties. The special technical feature of group IV is considered to be a distinct method wherein the method use of a PDK2 drug to prepare a medicant to treat a disease associated with a polymorphisms at position 288 of the PDK2 gene. The special technical feature of group V is considered to be a distinct method wherein the method use of a PDK2 drug to prepare a medicant to treat a disease

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associated with a polymorphisms at position 1281 of the PDK2 gene. The special technical feature of group VI is considered to be a distinct method wherein the method use of a PDK2 drug to prepare a medicant to treat a disease associated with a polymorphisms at position 1357 of the PDK2 gene. Groups IV-VI do not share a special technical feature because each of the polymorphisms detected in the methods of groups IV-VI are distinct and have their own structural and functional properties. The special technical feature of group VII is considered to be a distinct product drawn to a computer readable medium comprising sequence information for the polymorphism at position 288 of the PDK2 gene. The special technical feature of group VIII is considered to be a distinct product drawn to a computer readable medium comprising sequence information for the polymorphism at position 1281 of the PDK2 gene. The special technical feature of group IX is considered to be a distinct product drawn to a computer readable medium comprising sequence information for the polymorphism at position 1357 of the PDK2 gene. Groups VII-IX do not share a special technical feature because each of the polymorphisms detected in the methods of groups VII-IX are distinct and have their own structural and functional properties. It is noted that Applicant is entitled to an examination of the first product, method of making said product and method of using said product. In the instant Application, the methods of groups IV-VI constitute additional and distinct methods. Further, the products of groups I-III are distinct from the products of groups VII-IX. The nucleic acids of groups I-III are comprised of nucleotides and are useful in methods such as nucleic acid hybridization, whereas the computer readable mediums of groups VII-IX are comprised of computer

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hardware and software and can be used in a storage capacity or may be utilized in methods for searching a databank. Accordingly, restriction of groups I-IX is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

A telephone call was made to Donald Bird on July 18, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. The fax number for the Technology Center is (703)-305-3014 or (703)-305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

  
CARLA J. MYERS  
PRIMARY EXAMINER

July 22, 2002